

Remarks

This application has been reviewed in light of the Final Office Action of April 18, 2006. Claims 1-5 and 7-15 are pending, and all claims are rejected. In response, the following remarks are submitted. Reconsideration of this application is requested.

Applicants note that while claims 1-5 and 7-15 are rejected, the Examiner also upheld the Restriction Requirement in the Final Office Action introducing an apparent conflict as to whether all claims were or were not considered in making the rejection. Applicants respectfully request the Examiner clarify his position in the next Official Communication.

Ground 1. Claims 1-5 and 7-15 are rejected under 35 USC 103 over Applicant's Admitted Prior Art (AAPA) in view of Ingall U.S. Patent 5,360,961 and/or the English-language Abstract and drawings of JP 11-336502. Applicant traverses this ground of rejection.

None of the references are properly applied in rejecting the present claims.

The AAPA does not legally qualify as prior art and may not be used in constructing the rejection. MPEP 2129 II provides what may be used as prior art from the Specification:

"Where the specification identifies work done by another as 'prior art,' the subject matter so identified is treated as admitted prior art."

This position is supported in the MPEP by a reference to In re Nomiya, "holding applicant's labeling of two figures in the application drawings as 'prior art' to be an admission that what was pictured was prior art relative to applicant's improvement."

The present Specification does not label or otherwise identify anything as "prior art," and specifically does not identify the material in para. [0003]-[0005] as "prior art." Accordingly, under the rules of the MPEP, this material in para. [0003]-[0005] may not be used as admitted prior art for the reasons set forth in MPEP 2129 II, and the AAPA must be withdrawn as a reference to conform to the practice mandated by MPEP 2129 II.

In the present case, the attempted application of the AAPA seeks to use the inventors' own work against them, see the last sentence of para. [0005]. A key reason why MPEP 2129 II places a strict limit on what can be used as prior art from the Specification is

the risk that those seeking to construct a rejection may construct a hindsight rejection and fail to consider the entire disclosure, adopt only the portions that are favorable to the rejection, and use the inventors' own work against them.

In the Response to Arguments, fourth paragraph of page 5 of the Final Office Action, a portion of MPEP 2129 is quoted, "When Applicant states that something is prior art..." This quote is fully consistent with Applicant's position above. Applicant has not stated that anything is prior art. Accordingly, the AAPA is not properly applied to reject the claims.

The Response to Arguments discusses two U.S. Patents, U.S. 5,188,507 and U.S. 4,552,509 (Final Office Action, page 6, lines 2-3). If these two patents are to be relied upon, they must be made part of the statement of the rejection.

The Response to Arguments misstates Applicant's position, "Now Applicant is couching this matter as a trade secret..." (Final Office Action, page 6, lines 10-13) Applicant has no idea where this argument comes from. Applicant has never used the term "trade secret" in stating its position, and has never suggested anything about "trade secret." Nor did Applicant ever suggest that "...the matter was prior art."

There is a second reason why the AAPA may not be used in rejecting the claims. If, *arguendo*, the material stated in para. [0003]-[0005] of the present Specification were presented in a proper prior art reference, it would teach away from the present approach. The emphasis-added portion on page 3 of the Final Office Action teaches that "...the support region is coated with a thermally sprayed wear-resistant coating," which is not welding. The rejected claims all recite "welding a wear-resistant material" (quote from claim 1) or the like. The emphasis-added portion in the Final Action teaches away from the recited "welding."

It is a well-established principle of law that a *prima facie* case of obviousness may not properly be based on a reference which teaches away from the present invention as recited in the claims.

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. In re Sponnoble, 160 USPQ 237 244 (CCPA 1969)...As "a useful general rule,"..."a reference that 'teaches away' can not create a prima facie case of obviousness." In re Gurley, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994)."

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Ingall discloses improving the wear resistance between two rotating shrouds that may contact each other along their edges by applying a coating to the edges 20 and 22 of the rotating shroud 18 (col. 3, lines 11-21 and Figure 1). JP '502 deals with the same part of the engine as Ingall and deals with the same problem and solution, see Abstract and Figures 1 and 3.

That is, neither Ingall nor JP '502 deals with the subject matter of the present claims, the welding of a wear resistant material to the vane-support area or the case-support area. Ingall and JP '502 are therefore nonanalogous art, and may not be applied in rejecting the present claims. Stated alternatively, Ingall and JP '502 are not within the scope and content of the prior art that may be used in forming a sec. 103 rejection. Their teachings are therefore not properly applied to reject the claims. To be analogous art and properly used in forming a sec. 103 rejection, a reference must be concerned with the same problem as another reference and the claims which are being addressed. See, for example, Medtronic, Inc. v. Cardiac Pacemaker, Inc., 220 USPQ 97, 104 (Fed. Cir. 1983), stating: "Faced with a rate-limiting problem, one of ordinary skill in the art would look to the solutions of others faced with rate-limiting problems." In the present case, the inventor was concerned with a problem in protecting the vane-support area and/or the case-support area, see the Background section of the Specification, and the remainder of the disclosure and claims. Ingall and JP '502 have nothing at all to do with this subject, and therefore are not properly within the scope of the prior art. They are therefore not properly applied in rejecting the present claims.

Claim 1 recites in part:

"a vane-support area of the turbine vane contacts a case-support area of the turbine outer case;"

"welding a wear-resistant material to a weld area of at least one of the vane-support area and the case-support area."

No prior art reference has such a teaching.

Applicant asks that the Examiner reconsider and withdraw this ground of rejection.

CONCLUSION

For at least the reasons set forth above, Applicant respectfully requests reconsideration of the Application and withdrawal of all outstanding rejections. Applicant respectfully submits that the claims are not anticipated by, nor rendered obvious in view of, the cited art either alone or in combination and thus, are in condition for allowance. Thus, Applicant requests allowance of all pending claims in a timely manner. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact the Applicant's undersigned representative.

This Response has been filed within two (2) months of the mailing date of the Final Office Action and it is believed that no fees are due with the filing of this paper. In the event that Applicant is mistaken in these calculations, the Commissioner is hereby authorized to deduct any fees determined by the Patent Office to be due from the undersigned's Deposit Account No. 50-1059.

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